

Application No.: 10/772,045

Case No.: 56165US011

Remarks

We have cancelled claims 1 through 5 so that only claims 6 through 10 are now pending. Claim 6 has been amended to clarify that the lengths of decorative film tape have already been applied in the claimed pattern.

§ 103 Rejections

The Examiner has rejected claims 6-10 under 35 USC § 103(a) as being unpatentable over Sundet (#5,665,446) in view of Futhey (#5,840,407).

Sundet describes a laminate that can be adapted for use to decorate a substrate, which, like the laminate according to the present invention, comprises (1) a layer of pre-mask material comprising a cover layer and a layer of removable adhesive firmly adhered to one surface of the cover layer; (2) a plurality of decorative films each having a layer of adhesive along one of their major surfaces; and (3) a release liner with a first major surface adapted to be releasably adhered to by the removable adhesive on the cover layer and by the adhesives on the decorative films. Also, as in the laminate according to the present invention, the decorative films of Sundet are applied to the first surface of the release liner in a pattern, and the layer of removable adhesive included in the layer of pre-mask material is adhered over the outer major surfaces of the decorative films adhered to the release liner and to the release liner around the decorative films.

Unlike the laminate according to the present invention, however, the decorative films or "graphics" in the laminate of Sundet are each formed in one piece by cutting them from a large sheet of the film material as with a computer controlled knife or a die cutter and then removing the weed from around the decorative films (see column 5, lines 33-41 of Sundet). Thus the decorative films have shapes such as the W illustrated in Figure 1 of the drawing in Sundet.

In contrast, the laminate adapted for use to decorate a substrate according to the present invention includes, instead of "graphics" of the type described by Sundet that are each formed in one piece by cutting them from a large sheet of the film material, a plurality of display lengths of decorative film tape each comprising a length of decorative film having opposite parallel edge surfaces, opposite end surfaces at opposite ends of the length of decorative film, opposite major surfaces extending between said edge and end surfaces, and a layer of adhesive along one of the

Application No.: 10/772,045Case No.: 56165US011

major surfaces; which display lengths of decorative film tape have different lengths and shapes of their end surfaces formed by a computer operated tape applicator and have been applied to the first surface of the release liner by that tape applicator with end surfaces of some of the display lengths closely spaced from each other to form a decorative pattern comprising a plurality of pattern portions, each of which pattern portions is formed by four display lengths of decorative film having adjacent closely spaced end surfaces and extending in four different directions from those adjacent closely spaced end surfaces, with the closely spaced end surfaces of the four display lengths of decorative film each having two projecting surface portions disposed at an angle with respect to each other.

There is no teaching or suggestion in Sundet to form graphics from such lengths of tape having parallel side surfaces by placing ends of the lengths of tape closely together or of the type of pattern portions four display lengths of decorative film having adjacent closely spaced end surfaces and extending in four different directions from those adjacent closely spaced end surfaces, with the closely spaced end surfaces of the four display lengths of decorative film each having two projecting surface portions disposed at an angle with respect to each other.

The Examiner has acknowledged that Sundet does not form graphics from lengths of tape as does the present invention by citing Futhey. Futhey et al. describes lengths of decorative film of a type that can be used in the claimed laminate. Applicants acknowledge that such lengths of decorative film were well known prior to the present invention, and that such lengths of decorative film have been used to decorate substrates particularly including glass substrates. There has, however, been no laminate of the type claimed that includes such lengths of decorative film that have been formed and applied by a computer operated tape applicator to form graphics from such lengths of tape having parallel side surfaces by placing ends of the lengths of tape closely together or of the type of pattern portions four display lengths of decorative film having adjacent closely spaced end surfaces and extending in four different directions from those adjacent closely spaced end surfaces, with the closely spaced end surfaces of the four display lengths of decorative film each having two projecting surface portions disposed at an angle with respect to each other.

# BEST AVAILABLE COPY

2006-Jan-20 03:50 PM

3M

6517366133

7/8

Application No.: 10/772,045

Case No.: 56165US011

The claimed plurality of pattern portions in the laminate according to the present invention are important as they allow formation of many different decorative patterns with the lengths of decorative film in the laminate, two of which are illustrated in Figures 1 and 7 of the drawing.

Even if, for the sake of argument, the Examiner is correct in not attributing any patentable significance to the lengths of decorative film tape having been applied by a computer operated tape applicator (a supposition that applicants deny), there is no teaching or suggestion in the cited art of either the use of lengths of decorative film tape in a laminate of the type claimed or of pattern portions of the type claimed formed by such lengths of decorative film tape in such a laminate.

Thus, the laminate adapted for use to decorate a substrate according to the present invention as claimed in claim 6 is not made obvious by Sundet or of any combination of Sundet and Futhey. Claim 6 should be allowed.

Claims 7 through 10 are dependent on claim 6 and are thus allowable for all of the reasons given above with respect to claim 6. Also, those dependent claims recite structural features that are not taught or suggested by the cited art in the claimed combinations. For example:

Claim 7 recites that the spaces between the closely spaced end surfaces of the lengths of tape are in the range of 0.005 to 0.12 inch or 0.013 to 0.3 cm. As noted above, there is no teaching or suggestion in Sundet to form pattern portions from lengths of tape having parallel side surfaces by placing end surfaces of the lengths of tape closely spaced from each other, and therefore no suggestion of the claimed range of spaces between the closely spaced end surfaces of the lengths of tape.

Claim 8 recites that the decorative film in the lengths of tape has grooves or other structure along the major surface of the decorative film opposite the layer of adhesive so that the decorative film visually simulates a decorative structure. As noted above, the cited art does not teach or suggest a laminate of the type claimed that includes such lengths of decorative film.

Application No.: 10/772,045

Case No.: 56165US011

Claim 10 recites that the two projecting surface portions of each of the closely spaced end surfaces of the four display lengths of decorative film are disposed at a right angle with respect to each other. This is not shown in any of the cited art.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration, entrance of this amendment, and allowance of all of the claims in the application are respectfully requested.

The amendment to claim 6 was not earlier presented because the need for the clarification it provides was not appreciated prior to studying the claim in preparation for this response. Entrance of the amendment should not require any further search or a significant amount of work or consideration on the part of the Examiner.

Respectfully submitted,

*January 20, 2006*  
Date

By: W = J. Huebsch

William L. Huebsch, Reg. No.: 25,990  
Telephone No.: (651) 733-2835

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833

WLH/spg